

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1, 2, 7, 9-11 are rejected under 35 U.S.C. 102(b) over the patent to Hughes.

Claims 3-6, 8 are rejected under 35 U.S.C. 103(a) over the patent to Hughes (seemingly in combination with the patent to Sako).

At the same time, the Examiner indicated that claim 12 was not rejected over the art and was generally allowable.

The Examiner's indication of the allowability of claim 12 has been gratefully acknowledged. In connection with this indication, claim 12 has been rewritten in independent form by including into it the features of claim 9 of which it depends, and therefore this claim should be considered as being in allowable condition.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicant canceled claims 2 and 9 and submitted two new independent claims 13 and 14 which define a device

and a method for protecting a body part of a person from contact with a rotating saw blade in accordance with the present invention.

The retained dependent claims have been amended to depend on the new independent claims.

It is respectfully submitted that the new features of the present invention which are now defined in claims 13 and 14 are not disclosed in the prior art applied against the original claims. Claim 13 defines a device for protecting a body part of a person from contact with a rotating saw blade, which is configured as a circular saw, and, in addition to other features, defines that the sensor for generating and detecting an electromagnetic field situated in the vicinity of the saw blade and providing signals which are evaluated by an evaluation unit for generating an evaluation signal for controlling a movement of the saw blade, is positioned on the underside of a jam guard for the saw blade.

Claim 14 defines a method for protection of a body part of a person from contact with a rotating saw blade of the circular saw, in which the sensor is positioned on the underside of a jam guard for the saw blade and generates a high-frequency electromagnetic signal detected by an evaluation unit for influencing the rotation of the saw blade.

Turning now to the references and in particular to the patent to Hughes, it can be seen that this reference discloses a proximity responsive capacitive sensitive method, system and associated electrical circuit for use in controlling mechanical and electro-mechanical equipment.

In his rejection of the claims the Examiner indicated that claims 1 and 9 can be considered as fully disclosed in the patent to Hughes. Applicant agrees with the Examiner's opinion about the pertinence of the patent to Hughes with the present invention as defined in original claims 1 and 9. However, this reference does not teach the above mentioned new features of the present invention as now defined in claims 13 and 14 as specified above. As for the anticipation rejection, it is believed to be advisable to cite the decision in re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Hughes does not disclose each and every element of claims 13 and 19, and therefore the anticipation rejection of the original claims should be considered as no longer tenable with respect to claims 13 and 14 and should be withdrawn.

The patent to Hughes also does not provide any hint or suggestion for the features which are now defined in claims 13 and 14 in the sense of obviousness, while the patent to Sako can not be considered as a valid reference. The present application was filed in the United States on September 28, 2004 and claims its priority from December 22, 2002, while the patent to Sako was filed in the United States on November 12, 2003 that is later than the priority date of the present application.

As for the obviousness rejection based on the patent to Hughes, it is respectfully submitted that in order to arrive at the applicant's invention from the teaching of this reference, the reference has to be fundamentally modified by including into it the new features of the present invention as defined in claims 13 and 14.

However, It is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its

structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments, it is believed that claims 13 and 14 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the corresponding independent claims, they share their presumably allowable features, and therefore it is believed that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, consisting of a stylized 'S' followed by a horizontal line and a small flourish.

Michael J. Striker  
Attorney for Applicants  
Reg. No. 27233